PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number 1118 001 301 0202
I hereby certify that this correspondence is being facsimile transmitted to the USPTO on Nov. 21, 2005 To telephone number 571-273-8300. Signature Typed name **Duane C. Basch, Reg. No. 34,545**	Application Number **10/717,887** Filed **November 20, 2003** First Named Inventor **Michael W. Allen** Art Unit 2838 Examiner R. Patel

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☒ attorney or agent of record.
Registration number **34,545**.

☐ attorney or agent acting under 37 CFR 1.34.

☐ Registration number if acting under 37 CFR 1.34

Signature

Typed name **Duane C. Basch**

Telephone number **585-899-3970**

Date 11/21/05

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

Total of forms are submitted.

Attachment to
Pre-Appeal Brief Conference Request

Application No.: 10/717,887

ARGUMENTS TO BE CONSIDERED BY PRE-APPEAL BRIEF CONFERENCE PANEL

Rejection: Claims 8 – 14 were rejected under 35 USC §102(e) as being anticipated by Wong et al. (6,775,164). Claims 1 – 7 and 14 – 21 were rejected under 35 USC §103(a) as being unpatentable over Squibb (5,499,184) in combination with Keith (5,395,264).

Errors in Rejection: (I) failure of alleged anticipatory reference (Wong) to teach all elements of rejected claims; (II) inadequate basis for combination of references (Squibb and Keith) – no motivation to combine/modify; and (III) even if Squibb and Keith are combined, the combination fails to teach all recited elements. These arguments are submitted in addition to the Response After Final (no amendments) submitted concurrently herewith, Applicants respectfully traverse the rejections.

I. In formulating the rejection under 35 USC §102 the Examiner fails to show where the alleged anticipatory reference (Wong) teaches all elements of the rejected claims 8 - 14.

With regard to the rejection based upon Wong, Applicants respectfully traverse the rejection as failing to teach all of the limitations recited in claim 8, as well as the limitations of dependent claims 9 – 13. Wong discloses a pulse width modulation (PWM) controller integrated circuit suitable for use in a switching power supply, among other devices. Although Wong does teach several similar components, the specific limitations and relationships of the components as recited in claim 8 are not disclosed by Wong. In particular, there is no teaching in Wong of the encapsulation of the switching power supply as expressly recited in claim 8. Nor is there a disclosure that the MOSFET is connected to the DC return path of the bridge rectifier. Wong further fails to teach or suggest a voltage level detection circuit to maintain the MOSFET switch in an off state until a line voltage reaches a near zero threshold. Applicants note that the Examiner bases the rejection on a recited photodetector (64) – which appears to be erroneously cited in the rejection as both a photodetector and a detection circuit.

The resistive charging path, specifically recited as turning the MOSFET switch to an on state once the line voltage reaches the near zero threshold, has been alleged to be taught by a "bias pin 47" that enables bias power to be applied to the Wong integrated circuit (col. 4, lines 1 – 5). Applicants respectfully contend that such a

teaching does not give rise to the claimed limitation of a resistive charging path turning the MOSFET switch to an on state. Lastly, claim 8 further recites "a resistive connection to a housekeeping supply of the power converter which maintains the MOSFET switch in the on state." The rejection alleges that such a limitation is taught by the AC connections of Wong. However, a careful review of the instant application reveals the recited housekeeping supply (depicted in FIGS. 4A and 4B) is in addition to the AC inputs. Thus, the recited housekeeping supply of the power converter cannot be taught by the Examiner's incorrect reference to AC connections.

Furthermore, in the Examiner's remarks set forth at p. 2 of the Office Action, the Examiner further alleges that "also encapsulated circuit which known in the art." However, the Examiner has failed to cite where the recited "current limiting circuit encapsulated with the power converter" (claim 8) is taught by Wong. Moreover, the Examiner appears to rely upon Squibb (5,499,1984) as teaching the recited encapsulation. Applicants believe that such a position is wholly unsupported by the cited patent (notwithstanding the fact that Squibb is not even cited in the rejection of claim 8 under 35 USC §102). Nor has the Examiner indicated where, in Squibb, there is a teaching of encapsulation (the word "encapsulate" does not appear in Squibb). Applicant notes, for the Examiner's careful consideration that the term "encapsulate" has a meaning commonly used in the electrical engineering art and that the term is used consistently in the instant application (e.g., lines 19-22 of the Specification). In view of the various limitations not taught by Wong, Applicants again urge that claim 8, and all claims dependent therefrom, are not anticipated under 35 USC §102(e) by Wong et al., and claims 8 - 13 are therefore in condition for allowance.

Claim 14: Applicants also noted that claim 14 appears to have been erroneously included in the rejection under 35 USC §102, and have requested confirmation of the noted error, so that an accurate characterization of the rejections may be set forth for the Appeal.

(II) No evidentiary basis for the combination of references - no motivation to combine/modify Squibb and Keith is found in the rejection.

With respect to the proposed combination of Squibb and Keith, there is simply no basis for urging that one of ordinary skill in the art would have been motivated to make such a combination. In the rejection, the Examiner urges that it would have

been obvious to "modify Squibb's power supply by utilizing the technique taught by Keith for the purpose of providing power supply that can be used with standard power supply." Not only is there no indication of where such a suggestion might be found in the references, the statement itself is unclear ("providing power supply that can be used with standard power supply"). Absent a specific teaching or suggestion of the combination or motivation to make the modifications, *prima facie* obvious has not been established.

Applicants further urge that the only commonality between Squibb and Keith is that the term AC is used by both – yet Keith clearly teaches an alternative, and incompatible, use of AC cords for audio signal transmission. Given that the combination of Squibb and Keith would render either invention wholly inoperable, there cannot be any basis for the proposed combination – other than Applicants' claims, which appear to have been employed as a "recipe" for hindsight reconstruction of the invention.

(III) The arguable combination of Squibb and Keith fails to teach all recited elements

Squibb is directed to a power switching circuit for remotely activating a power supply, where the power switch is electrically isolated from the primary of the power supply. Squibb also teaches how to use an auxiliary oscillator to provide a low voltage isolated remote on/off control. To the best of Applicants knowledge, in addition to failing to teach a detachable line cord (not being a power converter, but a remotely controllable aspect of a power supply), Squibb also fails to teach the use of an encapsulant for high-voltage electronic circuitry in a power converter, as recited in claims 1 and 14.

With respect to the various limitations of the rejected dependent claims, Applicants contend that resistor 58 of Squibb, cited in the rejection, cannot give rise to the recited inrush current limiting circuit. Applicants note the function of the inrush circuit embodiments depicted in FIGS. 4A and 4B, and the general description where "the inrush current controller 112, holds back on the input voltage from line 102 until such a time when the incoming AC voltage is near zero. At that time, circuit 112, connects capacitor(s) 130 to the bridge rectifier, allowing capacitor(s) 130 to charge with the rising sinusoidal voltage waveform." (see Specification, p. 6, line 28 – p. 7, line 4 – 8). No teaching of an inrush current limiting circuit is believed to be found in Squibb.

Keith, cited in the rejection for teaching an integrated connector in a power controller, actually teaches the use of a standard AC extension cord to pass audio signals. Not only does Keith fail to teach or suggest a power controller having an integrated connector (claims 1 and 14), the patent also fails to suggest "connection to an AC utility line source that is independent of the circuit board to which the power converter is attached" (e.g., claim 15). Accordingly, Keith's teachings relative to an integrated connector do not appear in any way to suggest the recited limitations. In fact, the teachings of Keith relate to use of AC extension cords as audio cables, which is entirely contrary to the present invention (and to Squibb) – as a source of power for a power converter. Thus, Keith also clearly teaches away from the proposed use or modification.

The obviousness rejection also fails to set forth where the recited elements of claim 14 are found in either Squibb or Keith , for example, a circuit board located within an electronic device, a cover enclosing the electronic device, and an electronic power converter including fully encapsulated electronic circuitry; and an integrated connector, accessed through an aperture in the cover, for receiving a detachable line cord having at least two wires therein, wherein the power converter is mounted on the circuit board. Absent teaching of the recited elements, Applicants again urge that no *prima facie* obviousness has been established and the rejection is respectfully traversed.

Similarly, relative to the various dependent claims, while certain components are recited, Squibb and Keith fail to teach or suggest the specific limitations set forth in the dependent claims. For example, claims 2 and 17 recite a "MOSFET switch connected to the DC return path of the bridge rectifier" (emphasis added). Although a MOSFET may be taught by Squibb, no such use or interconnection has been disclosed in Squibb. Furthermore, although an opto-coupler is disclosed, there does not appear to be any characterization of its use to "to disable the power supply output in response to the signal received by the photo-detector," as recited in claims 3 or 18. With reference to claims 6 and 21, these claims recite a "secondary side, isolated low voltage ON/OFF function" implemented by circuitry including a peak detector for sensing the instantaneous primary rectified voltage connected to a linear regulator / voltage limiting circuit, connected to a light emitter of an opto-coupler, said opto-coupler being further connected to an error amplifier and an ON/OFF pin in such a manner as to provide a isolated secondary low voltage indication of the primary line

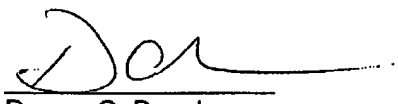
voltage and to allow the user to turn the device off." Here again, no such interrelationship between components is believed to be taught or suggested in Squibb or Keith.

Applicant's further note that in response to arguments similar to those presented above, the Examiner's Response to Arguments found in the present Office Action, once again fails to indicate the basis for the rejection. In view of the above-noted claim limitations (independent and dependent), Applicants respectfully submit that the teachings of Squibb and Keith fall well short of teaching the claim elements that they are urged to disclose, and that *prima facie* obviousness has not be established to which Applicants can or should further respond.

In view of the above-noted distinctions, as well as the lack of a teaching or suggestion by which Squibb and Keith are proposed for combination/modification, Applicants respectfully contend that claims 1 and 14 are presently in condition for allowance, the rejection having been traversed. Insofar as claims 2 – 6 and 15 - 21 are concerned, these claims all depend from now presumably allowable claims 1 or 14 and are also believed to be in allowable condition for the reasons hereinbefore discussed with regard to such claims.

Conclusion: in view of the reasons set forth above, and in the Response After Final submitted concurrently herewith, the Pre-Appeal Brief Conference Panel is respectfully requested to reconsider and instruct the Examiner to withdraw the present rejections and indicate the allowance of the current claims.

Respectfully submitted,



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